

## **REMARKS**

Claims 1-5 are pending. The amendment to claim 5 is editorial in order to better conform with U.S. patent practices and would not narrow the scope of the claim.

### **Finality of the Office Action**

The Office Action Summary erroneously indicates that the Office Action was final because page 6, the 4<sup>th</sup> line from the bottom, of the Office Action states that “this action is not being made FINAL.” In fact, the Examiner confirmed in a telephone interview that the box for “This action is FINAL” was mistakenly checked in the Office Action Summary and the finality would be withdrawn.

### **Objection to Specification**

The specification is objected to for improper idiomatic English. Applicants hereby submit a substitute specification with proper idiomatic English. Withdrawal of the objection is respectfully requested.

### **Claim Rejections – 35 USC § 102**

Claims 1-5 were rejected under 35 USC § 102(b), as allegedly being anticipated by EP 1055506 (hereinafter “Ref. 1”); JP 2000169602 (hereinafter “Ref. 2”); JP 2001169601 (hereinafter “Ref. 3”); JP 2000135737 (hereinafter “Ref. 4”); JP 2002046176 (hereinafter “Ref. 5”); JP 2002046173 (hereinafter “Ref. 6”); JP 2001205703 (hereinafter “Ref. 7”); JP 2000167928 (hereinafter “Ref. 8”); and JP 2002046178 (hereinafter “Ref. 9”). Claims 1-5 were also rejected under 35 USC § 102(e), as allegedly being anticipated by Ito et al. (US 6,451,445; hereinafter “Ref. 10”). Applicants respectfully traverse the rejections.

The Office Action contends that each of Ref. 1-10 discloses a heat-shrinkable polyester film having the heat-shrinkage characteristics as recited in the claims. Applicants respectfully disagree. The Office Action also contends that Applicants have not shown why it is not inherent for a heat-shrinkable polyester film that satisfies elements (A) and (B) recited in the claims to also satisfy element (C) as recited in the claims. Applicants submit that the cited references do not inherently teach a heat-

shrinkable polyester film having the heat-shrinkage characteristics as recited in element (C) of the claims at least because each of Ref. 1-10 employs polyester film drawing conditions different from the polyester film drawing conditions used to make the heat-shrinkable polyester film of the claimed invention.

As stated on page 10, lines 4 – 8 of the originally-filed specification, the heat shrinkage percentage  $\Delta$  as recited in element (C) of the instant claims is provided by optimizing the compositions of the polyesters and controlling the film drawing conditions. Specifically, the film drawing process of the claimed invention is conducted in two steps or more. *See* page 31, lines 1 – 6, the original specification. For a two-step drawing, for example, the heat-shrinkable polyester film of the claimed invention is (a) subject to a first drawing, (b) heat-treated while slightly tensioned in the drawing direction (*i.e.*, heat-set), (c) subject to a second drawing, and (d) followed by cooling while slight tensioned. Those Examples that satisfy element (C) were obtained through this two-step drawing process. On the other hand, for instance, for Examples 4, 9, and 10, the heating setting and cooling steps were not performed, and as a result, these Examples had heat shrinkage percentages  $\Delta$  of 22%, 30%, and 26%, respectively, which do not satisfy element (C).

Ref. 1-10 only disclose the drawing temperature and drawing ratio used in subjecting polyester films to a drawing process. None of Ref. 1-10 cited, however, discloses a multi-step drawing process including the heat-setting of the polyester film under a slight tension in the direction of the first drawing between the first and second drawings and a cooling step under a slight tension after the second drawing. For example, Ref. 1 discloses merely drawing a polyester film along the longitudinal direction, preheating, and then drawing the polyester film along the transverse direction. *See* paragraphs [0037] and [0041]-[0043] on page 4. Ref. 1 does not disclose subjecting the polyester film to a first drawing, heating the polyester film under a slight tension in the direction of the first drawing after the first drawing of the film, subjecting the polyester film to a second drawing, and cooling the polyester film under a slight tension after the second drawing as disclosed in page 31, line 5 to page 32, line 10, the original specification. The film drawing processes employed by Ref. 2-10 are similar to the film

drawing process employed by Ref. 1. For instance, the film drawing process disclosed in Ref. 10 is identical to that of Ref. 1. *See* col. 5, lines 4 – 17. In fact, the examples of Ref. 5 and 9 employed merely a one-step drawing process on the polyester films. The polyester film of Ref. 6 was not subject to heating under a slight tension along the direction of the first drawing.

Because the heat shrinkage characteristics depend on the drawing condition of the film, the films disclosed by the references cited are different from the films instantly claimed. Using any of the film drawing processes disclosed in Ref. 1-10, the resulting polyester film would not achieve the heat shrinkage characteristics as recited in element (C) of the instant claims. For instance, Example 1 of Ref. 4 is identical to Example 4 disclosed by the present application. As shown in Table 4 on page 56 of the Specification, the difference in heat shrinkage percentage  $\Delta$  is 22%, which does not satisfy the limitation of the instant claims.

Therefore, none of the cited references discloses a heat-shrinkable polyester film having the heat shrinkage characteristics as recited in the claims.

For at least the reasons stated above, withdrawal of the anticipatory rejections is requested.

#### **Double Patenting Rejections**

Claims 1, 3 and 5 were rejected on the ground of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 1, 3 and 4 of US Patent No. 6,458,437 (hereinafter “Ref. 11”), claims 1, 3 and 4 of US Patent No. 6,663,928 (hereinafter “Ref. 12”), and claims 1, 2 and 7 of US Patent No. 6,548,595 (hereinafter “Ref. 13”). Applicants respectfully traverse the rejections.

Applicants contend that the heat-shrinkable polyester films of claims 1, 3 and 4 of Ref. 11 and 12, and claims 1, 2 and 7 of Ref. 13 do not have the heat-shrinkage characteristics as recited in element (C) of the instant claims 1, 3 and 5 because Ref. 11-13 do not disclose the multistep drawing process (comprising heating the polyester film after the first drawing under a slight tension along the direction of the first drawing, and

cooling the polyester film after the second drawing under a slight tension) disclosed in the present application. *See* col 5, lines 44 – col. 6, line 4, Ref. 11; col. 5, lines 27 – 67, Ref. 12; and col. 4, lines 23 – 52, Ref. 13. For instance, Ref. 11-13 discloses only the drawing temperature and drawing ratio (column 5, lines 44-48 and column 6, lines 5-18; Ref. 11; column 5, lines 27-43, Ref. 12; column 4, lines 23-30 and 53-67). In Example 1 of Ref. 11, 12 or 13, only a one-step drawing process was used to make the heat-shrinkable polyester film claimed in these U.S. patents. As a result, the polyester films according to claims 1, 3 and 4 of Ref. 11 and 12, or claims 1, 2 and 7 of Ref. 13 do not inherently satisfy element (C) as recited in the instant claims. Nor is it obvious for one of ordinary skill in the art to modify the polyester films claimed in Ref. 11-13 to obtain the polyester film as instantly claimed.

Also, to advance prosecution, but without acquiescence to the rejection,  
Applicants hereby submit a terminal disclaimer over Refs 11-13.

For at least the reasons stated above, withdrawal of the obviousness-type double patenting rejections is respectfully requested.

## **CONCLUSION**

Applicants submit that the claims are allowable. An early and favorable action to that effect is respectfully requested.

The Examiner is invited to contact the undersigned to discuss any issues regarding this response.

In the event that the filing of this paper is deemed not timely, applicants petition for an appropriate extension of time. The Office is authorized to charge any underpayment or credit any overpayment to Kenyon & Kenyon LLP's Deposit Account No. 11-0600.

Respectfully submitted,  
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